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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/773,353 | 01/31/2001 | Neil R.N. Enns | 13768.178.1 | 4025 |

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| EXAMINER | |
|---|---|
| HASHEM, LISA | |

| ART UNIT | PAPER NUMBER |
|---|---|
| 2645 | |

DATE MAILED: 02/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

| Office Action Summary | Application No. | Applicant(s) | |
|---|---|---|---|
| | 09/773,353 | ENNS ET AL. | |
| | Examiner | Art Unit | |
| | Lisa Hashem | 2645 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on 29 December 2004.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) 1-33 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) 1-33 is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

## DETAILED ACTION

### *Oath/Declaration*

1. The declaration filed on December 29, 2004 under 37 CFR 1.131 is sufficient to overcome the Dejaco reference (based on Exhibit D).

(Note: Exhibit A, B, and C show no facts of reduction to practice to one of ordinary skill in the art and do no support facts of all claimed limitations in the instant application, e.g. diverting to a temporary storage within a mobile device, audio content stored in temporary storage limited to a predetermined maximum, displaying a progress indicator, displaying an indicator that audio content has been attached, and displaying a size of the attached audio content).

### *Claim Rejections - 35 USC § 102*

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-4, 6-8, 10-13, 16-20, 22-23, 25-28, and 30-32 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by U.S. Patent No. 6,351,523 by Detlef, hereinafter Detlef.

Regarding claim 1, Detlef discloses in a computerized system (see Fig. 1) that includes one or more mobile devices or thin client devices (Fig. 1, 12; col. 3, lines 64-67) and an electronic message server ( Fig. 1, 36) supporting wireless communication, wherein at least some of the mobile devices have an input system that is optimized for numeric input rather than text input (col. 1, lines 35-57), and wherein at least some of the mobile devices are capable of sending and receiving electronic messages (col. 3, lines 51-50), a method of composing an

electronic message using a mobile device (see Abstract and Fig. 2, 12), the method comprising acts of: receiving a command to begin composing an electronic message at a mobile device; receiving a command to add audio content to the electronic message at the mobile device; inherently diverting to a temporary storage within the mobile device, an audio content stream within the mobile device received at an audio input; storing the audio content stream in a format that is compatible with adding audio content to the electronic message; and attaching the formatted audio content to the electronic message at the mobile device (col. 1, lines 58-63; col. 4, lines 30-40; col. 5, lines 13-25).

Regarding claim 2, a method as recited in claim 1, wherein Detlef further discloses the mobile device comprises a phone (Figure 2, 12) and the temporary storage inherently comprises a temporary data, and wherein the audio content stream received at the audio input is generated by a user speaking into the phone's mouthpiece (col. 1, lines 58-63; col. 4, lines 30-40; col. 5, lines 13-25).

Regarding claim 3, a method as recited in claim 1, wherein Detlef further discloses the electronic message comprises an electronic mail message, and wherein the formatted audio content is attached as an electronic mail attachment (col. 1, lines 58-63; col. 4, lines 30-40; col. 5, lines 13-25).

Regarding claim 4, a method as recited in claim 3, wherein Detlef further discloses the electronic mail message is composed in either replying to or forwarding a specific electronic mail message, the method further comprising an act of receiving the specific electronic mail message (col. 4, lines 30-40; col. 5, lines 13-25).

Regarding claim 6, a method as recited in claim 1, wherein Detlef further discloses the format used to store the audio content stream allows for data compression, the method further comprising an act of compressing the audio content stream in accordance with the storage format (col. 1, lines 58-63).

Regarding claim 7, a method as recited in claim 6, wherein Detlef further discloses the storage format is a WAV file format (col. 5, lines 13-25).

Regarding claim 8, a method as recited in claim 1, wherein Detlef further discloses receiving the command to add audio content to the electronic message is based on either selection of a user interface menu item to add audio content to the electronic message or a press of a record button (col. 5, lines 13-25).

Regarding claim 10, please see the rejections of the method in claims 1 and 2 mentioned above, to reject the method in claim 10.

Regarding claim 11 and 13, please see the rejections of the method in claims 4 and 6 mentioned above, respectively, to reject the method in claims 11 and 13.

Regarding claim 12, please see the rejections of the method in claims 3 and 7 mentioned above, to reject the method in claim 12.

Regarding claims 16, 17, 18, 19, and 22, please see the rejections of the method in claims 1, 2, 3, 4, and 6 mentioned above, respectively, to reject the method in claims 16, 17, 18, 19, and 22.

Regarding claim 20, please see the rejections of the method in claims 1 and 2 mentioned above, to reject the method in claim 20.

Regarding claim 23, please see the rejections of the method in claims 1 and 8 mentioned above, to reject the method in claim 23.

Regarding claims 25, 26, 27, 28, 30, 31, and 32, please see the rejections of the method in claims 1, 2, 3, 4, 6, 7, and 8 mentioned above, respectively, to reject the method in claims 25, 26, 27, 28, 30, 31, and 32.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claims 5, 14, 21, and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Detlef, as applied to claims 1, 10, 16, and 25 above, respectively, and further in view of U.S. Patent No. 6,600,814 by Carter et al, hereinafter Carter.

Regarding claim 5, a method as recited in claim 1, wherein Detlef does not disclose the total amount of audio content that may be stored in temporary storage is limited to a predetermined maximum and an act of displaying a progress indicator to show amount of temporary storage used.

Carter discloses a play back of text segments in an email to a user of a telephone handset comprising (see Fig. 2 and 3): the total amount of text segments that may be stored in a cache or storage (Fig. 2, 40) is limited to a predetermined maximum (col. 6, lines 17-33), and an act of inherently displaying a progress indicator (comparing the segments to the maximum) to show a current amount of temporary storage used in storing the text segments compared to the

predetermined maximum (col. 6, lines 33-36); wherein the text segments are converted to speech and played back to a user of the telephone handset (col. 6, lines 37-65).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method of Detlef to include a predetermined maximum of storage and a progress indicator as taught by Carter. One of ordinary skill in the art would have been lead to make such a modification since the memory is limited to a predetermined maximum and the audio content stored is compared to the predetermined maximum.

Regarding claims 14, 21, and 29, please see the rejection of the method in claim 5 above to reject claims 14, 21, and 29.

6. Claims 9, 15, 24, and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Detlef, as applied to claims 1, 10, 16, and 25 above, respectively, and further in view of U.S. Patent Application Publication No. US 2001/0045885 by Tett.

Regarding claim 9, a method as recited in claim 1, wherein Detlef does not disclose displaying an indicator that audio content has been attached to the electronic message and displaying a size of the attached audio content.

Tett discloses a method of composing an electronic message using a mobile device (section 0023, lines 1-7; section 0024, lines 9-11; section 0025, lines 1-14) comprising: composing an electronic message; adding audio content to the electronic message; and attaching the audio content to the electronic message (section 0032, lines 1-16). Wherein, Tett discloses acts of: displaying an indicator that audio content has been attached to the electronic message; and displaying a size of the attached audio content (see Fig 2, 214; section 0032, lines 1-16).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method of Detlef to include displaying an indicator that audio content has been attached to the electronic message and displaying a size of the attached audio content as taught by Tett. One of ordinary skill in the art would have been lead to make such a modification since the user of the mobile device can view the attachment and determine its size on the display of said device.

Regarding claim 15, please see the rejection of the method in claims 8 and 9 above to reject claim 15.

Regarding claims 24 and 33, please see the rejection of the method in claim 9 above to reject claims 24 and 33.

***Response to Arguments***

7. Applicant's arguments, see RCE, filed December 29, 2004, with respect to the rejection(s)of claim(s) 1-33 have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made of claims 1-33. Please see all rejections above.

***Conclusion***

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

- U.S. Patent No. 6,223,213 by Cleron discloses a thin client connected with a browser-based email system wherein a user may email a message with an audio attachment

9. Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington, D.C. 20231

**Or faxed to:**

(703) 872-9314 (for formal communications intended for entry)

**Or call:**

(703) 306-0377 (for customer service assistance)

Hand-delivered responses should be brought to: Crystal Park II, 2121 Crystal Drive, Arlington, VA, Sixth Floor (Receptionist).

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lisa Hashem whose telephone number is (703) 305-4302. The examiner can normally be reached on M-F 8:30-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on (703) 305-4895. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.

lh
February 17, 2005

FAN TSANG
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600